

dh



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
 United States Patent and Trademark Office  
 Address: COMMISSIONER FOR PATENTS  
 P.O. Box 1450  
 Alexandria, Virginia 22313-1450  
 www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/079,555

02/19/2002

Masashi Watanabe

02097/LH

9145

1933

7590

05/25/2006

FRISHAUF, HOLTZ, GOODMAN & CHICK, PC

220 Fifth Avenue

16TH Floor

NEW YORK, NY 10001-7708

EXAMINER

SINGH, SATWANT K

ART UNIT

PAPER NUMBER

2625

DATE MAILED: 05/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	10/079,555		WATANABE, MASASHI	
	<b>Examiner</b>		<b>Art Unit</b>	
	Satwant K. Singh		2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 08 March 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-3,8 and 10-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,8 and 10-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 June 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Response to Amendment***

1. This office action is in response to the amendment filed on 08 March 2006.

### ***Response to Arguments***

2. Applicant's arguments filed 08 March 2006 have been fully considered but they are not persuasive. Applicant argues that the prior art of Saito et al. (US 6,618,749) fails to disclose printing an image based on the delivery confirmation mail only if the delivery confirmation mail indicates failure of the communication of image data. The examiner respectfully disagrees. As disclosed by Saito et al the image data printed due to failure mail where the whole image of the original document is output (col. 7, lines 60-67) is different than the image printed due to the delivery status notification mail where only a part of the image information of the original document is output (col. 8, lines 21-30). Therefore, Saito et al discloses a printing an image based on the delivery confirmation mail, only if the delivery is a failure (Fig. 6, ST906-ST909) (col. 7, lines 60-67).

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

Art Unit: 2625

applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-3, 8, and 10-14 rejected under 35 U.S.C. 102(e) as being anticipated by Saito et al (US 6,618,749).

5. Regarding Claim 1, Saito et al discloses a facsimile apparatus comprising: a communication section which performs image data communication utilizing a mail transmission system of a computer network (IFAX 11) (e-mail transmitted from Internet facsimile (IFAX) 11 or personal computer (PC) 12 on the transmitting side is transmitted to IFAX 4 on the receiving side via Internet 13) (col. 3, lines 37-40); a printer (printer 27); a determining section which, if a delivery confirmation mail, which notifies whether delivery of the image data has succeeded or failed, has arrived, determines whether the delivery confirmation mail notifies a delivery failure of the image data transmitted from the communication section (failure mail identification section 31 judges that the received data is failure mail) (Fig. 9, ST901-904) (col. 7, lines 42-59); and a control section which causes the printer to print an image based on the delivery confirmation mail, only if the determining section has determined that the delivery failure is notified (Fig. 9, ST906-ST909) (received data is converted and output).

6. Regarding Claim 2, Saito et al disclose a facsimile apparatus, further comprising: an acceptance section which accepts a designation input by a user as to whether or not the delivery confirmation mail is requested, if the user requests transmission of the image data (delivery status notification mail identification section 32); and a request section which causes the communication section to perform transmission of the image

data together with a request for the delivery confirmation mail, if the designation that the delivery confirmation mail is requested is input to the acceptance section (transmit data from the IFAX) (col. 5, lines 7-30), wherein the control section causes the printer to print the image based on the delivery confirmation mail regardless of a determination result of the determining section, if the delivery confirmation mail has arrived in response to the transmission of the image data together with the request of the delivery confirmation mail in accordance with the designation input by the user (failure mail output from the IFAX) (col. 5, lines 43-48).

7. Regarding Claim 3, Saito et al disclose a facsimile apparatus, wherein the communication section transmits an e-mail, to which the image data is attached as an attachment file, based on an e-mail protocol (e-mail transmitted from a PC or another IFAX is received by control unit 21 vial the Internet according to STMP) (col. 4, lines 15-19).

8. Claims 8 and 12 are rejected for the same reason as claim 1.

9. Claims 10 and 13 are rejected for the same reason as claim 2.

10. Claims 11 and 14 are rejected for the same reason as claim 3.

### ***Conclusion***

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 2625

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

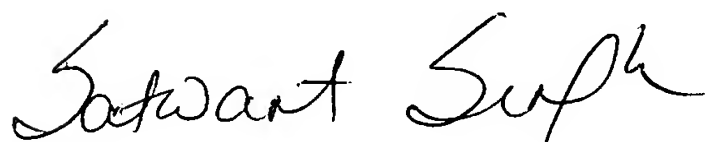
#### ***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Satwant K. Singh whose telephone number is (571) 272-7468. The examiner can normally be reached on Monday thru Friday 8am - 4:30pm.

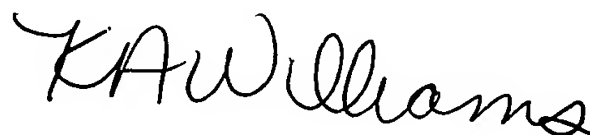
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly A. Williams can be reached on (571) 272-7471. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2625

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
sks

Satwant K. Singh  
Examiner  
Art Unit 2625



KIMBERLY WILLIAMS  
SUPERVISORY PATENT EXAMINER